

PATENT**Application # 10/733,719**

Attorney Docket # 2002-0465 (1014-048)

REMARKS

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the following remarks.

Claims 1-20 are now pending in this application. Each of claims 1, 15, and 20 are in independent form.

Consideration of Submitted References is Requested

On 2 May 2005, Applicant submitted an Information Disclosure Statement and PTO Form 1449 listing and providing 3 references. It is respectfully requested that those references be expressly considered during the prosecution of this application, that the references be made of record therein, and appear in the "References Cited" section of any patent to issue therefrom. It is respectfully requested that the next communication to Applicant include a copy of the Form 1449 with the Examiner's initials beside each listed reference.

The Obviousness Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Matsushita (U.S. Publication No. 2004/0056768), Amer (U.S. Patent No. 5,790,025), and Dodley (U.S. Patent No. 5,966,229). These rejections are respectfully traversed.

Matsushita, Amer, and/or Dodley do not establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior

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art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

A. All Elements Are Not Present in the Applied References

According to the Federal Circuit "[i]t is well settled that a patent applicant may be his own lexicographer." *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 316 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Applicants further note the official position of the USPTO regarding lexicography. The USPTO, in cooperation with the FTC and the Department of Justice, filed an Amicus Curiae brief, dated 20 September 2004, in *Phillips v. AWH Corporation*. The *Phillips* case is presently under consideration by the Federal Circuit sitting *en banc*. The USPTO's Amicus Curiae brief recites:

[t]he government maintains that the specification and prosecution history should receive more extensive consideration in claim construction than merely to rebut a dictionary either by lexicography or clear disclaimer, two relatively rare occurrences. The intrinsic evidence, including cited prior art, may indirectly convey the customary meaning of a disputed claim term, or will at least provide additional useful context that should be considered when consulting extrinsic evidence. In such cases, while lexicography does not explicitly define claim terms, "the specification may still define [them] 'by implication' such that the meaning may be found or ascertained by a reading of the patent documents." *Novartis Pharmaceuticals Corp v. Abbott Labs.*, 375 F.3d 1328, 1334 (Fed. Cir. 2004) (citations omitted). In *Vanderlande Ind. v. ITC*, 366 F.3d 1311, 1318 (Fed. Cir. 2004), this Court noted that the specification should first be consulted to

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determine if claim terms are expressly or *impliedly* defined. For example, where a claim term by itself might have several possible ordinary meanings, the specification or prosecution history may indicate the most appropriate definition, by context and implication. This Court has correctly observed that the use of “a claim term throughout the entire patent specification, in a manner consistent with a single meaning” may define that term “by implication.” *Bell Atlantic Network Services, Inc. v. Covad Communications Group*, 262 F.3d 1258, 1271 (Fed. Cir. 2001). Thus, in selecting among several possible ordinary meanings, one meaning may be inferred from the patent specification’s use of the term throughout in a manner consistent with that particular meaning of the term.

See, page 12-13.

Here, the claim phrase “Free Space Optical Communication (FSOC)” has been clearly defined in the specification, and that definition must control examination of those claims that recite this phrase.

Specifically, each of independent claims 1, 15, and 20 recite a “Free Space Optical Communication (FSOC)” “system” or “subsystem.” At least at paragraph 15 of the Specification defines the phrase “Free Space Optical Communications” to mean “a line-of-sight (LOS) technology that transmits a modulated beam of visible or infrared light through the atmosphere for broadband communications. In a manner similar to fiber optical communications, free space optics can use a light emitting diode (LED) or laser (light amplification by stimulated emission of radiation) point source for data transmission. In free space optics, however, an energy beam is collimated and transmitted through space rather than being guided through an optical cable. These beams of light, operating in the TeraHertz portion of the spectrum, can be focused on a receiving lens connected to a high sensitivity receiver through an optical fiber.”

Each of independent claims 1, 15, and 20 recites a “Free Space Optical Communication (FSOC)” “system” or “subsystem.” Contrary to assertions made on Pages 2-

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4 of the present Office Action, Matsushita does not expressly or inherently teach or suggest “a **Free Space Optical Communication (FSOC)**” “system” or “subsystem.” Instead, Matsushita allegedly recites “an area in which **solar cell modules** are installed.” See Abstract.

Claim 18 recites the “wherein the switch comprises an **optical attenuator**.” Contrary to the assertion on Page 3 of the present Office Action, Matsushita does not expressly or inherently teach or suggest a “switch” that comprises an “optical attenuator”.

Moreover, claim 19 recites “a **plurality of horizontal wires** at least partially surrounding a perimeter of an installation site of said FSOC subsystem.” Contrary to the assertion on Page 4 of the present Office Action, Matsushita does not expressly or inherently teach or suggest “a **plurality of horizontal wires** at least partially surrounding a perimeter of an installation site of said FSOC subsystem.” In fact, Matsushita does not even teach a single “horizontal wire”.

B. No Motivation or Suggestion to Combine Applied References

According to the Federal Circuit the “mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)). In that same case, the Federal Circuit further held that it “is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *Id.*, 23 USPQ 2d at 1784.

The present Office Action presents no evidence whatsoever that any of the applied references provide a suggestion or motivation for a combination with any of the other applied references. Instead, regarding the proffered combinations, the present Office Action recites:

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1. "it would have been obvious to the skilled artisan to employ the technique of Amer et al. as an alternative way of determining the nature and/or direction of the intruder's movements." *See* Page 4; and
2. "it would have been obvious to the skilled artisan to employ the teaching of Dodley et al. in the system of Matsushita et al. so that the emitted power is not harmful to the intruder which is an advantage." *See* Page 5.

Thus, the present Office Action fails to provide any evidence that the prior art provides any suggestion or motivation to combine the applied references. Accordingly, the combination of Matsushita with Amer and/or Dodley is impermissible.

C. No Explanation Stating Why Proposed Modifications Would Have Been Obvious to One Having Ordinary Skill in the Art

In order to establish a *prima facie* case of obviousness, an explanation must be provided stating why proposed modifications would have been obvious to one of ordinary skill in the art at the time the invention was made. *See*, MPEP §706.02(j). In other words, "there must be some suggestion..., either in the reference[]... or in the knowledge generally available to one of ordinary skill in the art, to modify the reference". *See* MPEP 2143.

The present Office Action recites conclusory statements that:

1. "[r]egarding claim 4: Matsushita et al. teach calculating a comparison calculated value D (paragraph 0028) but do not teach comparing a sensed voltage to a reference voltage. However, it would be an obvious to a skilled artisan to have the sensed voltage that can be compared to a reference voltage if desired." *See*, Page 2; and
2. "[r]egarding claim 11: Matsushita et al. do not teach detecting an absence of the intruder from a predetermined vicinity of the FSOC system. Since Matsushita et al. teach detecting means for detecting intrusion of an intruder into the restricted area (paragraph 0018), it would be obvious to a skilled artisan to recognize that the system

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of Matsushita et al. also teach detecting an absence of the intruder from a predetermined vicinity of the FSOC system." *See*, Page 3.

Yet, the present Office Action fails to establish a *prima facie* case of obviousness on either claim 4 or claim 11 since no explanation is provided regarding why the proffered modifications would have been obvious to one of ordinary skill in the art at the time the invention was made.

D. Lack Of Evidence Regarding Allegedly Inherent Material

"Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

The present Office Action recites that "[r]egarding claim 12: Matsushita et al. inherently teach increasing the emitted power of the FSOC system (paragraph 0047)." *See*, Page 3. No evidence has been presented that the admittedly "missing descriptive material is 'necessarily present'" in Matsushita. Applicants respectfully request provision of evidence supporting the assertion that "Matsushita et al. inherently teach increasing the emitted power of the FSOC system."

E. Conclusion

Thus, even if there were motivation or suggestion to modify or combine the applied references (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modify the applied references (another assumption that is respectfully traversed), the applied references still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

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Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

Applicant respectfully notes that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See In re Wiechert*, 152 U.S.P.Q. 247, 251-52 (C.C.P.A. 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

"none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely,

claims 1-14 are allowable because none of the references of record alone or in combination disclose or suggest 'sensing an intruder within a predetermined vicinity of a Free Space Optical Communication (FSOC) system; and reducing an emitted power of the FSOC system';

claims 15-19 are allowable because none of the references of record alone or in combination disclose or suggest 'a Free Space Optical Communication (FSOC) subsystem; and a sensor adapted to detect an intruder within a

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predetermined vicinity of the FSOC subsystem; and a switch adapted to reduce an emitted power of the FSOC subsystem, said switch coupled to said sensor'; and

claim 20 is allowable because none of the references of record alone or in combination disclose or suggest 'a Free Space Optical Communication (FSOC) subsystem; and means for sensing an intruder within a predetermined vicinity of the FSOC subsystem; and means for reducing an emitted power of the FSOC subsystem in response to sensing the intruder.'"

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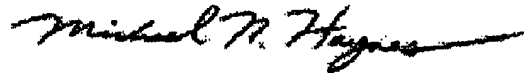
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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